

REMARKS

In response to the Restriction Requirement set forth in the Office Action of September 24, 2008, Applicants hereby provisionally elect with traverse the invention of Group II, claims 14-16, drawn to a compounds and compositions of formula (I).

In response to the Species Election Requirement, Applicants hereby provisionally elect, with traverse, the species of compound of 2-[(3-phenethyl-2,3-dihydro-benzofuran-5-ylmethyl)-amino]-N-methyl-propanamide described in Example 1 on page 18 of the specification and in claim 15 for examination on the merits.

It is respectfully submitted that at least claims 14-16 are readable on the elected species.

The reasons for traverse are as follows.

The requirement is improper as a matter of law. This application is a § 371 national stage application of International Application PCT/EP2005/000514. Accordingly, the Office is required to follow the rules regarding unity of invention in PCT rules 13.1 and 13.2. However, the Office appears to have improperly applied U.S. restriction practice for this application and not the PCT rules for unity of invention for the reasons discussed below. See, Caterpillar Tractor v. Commissioner of Patents and Trademarks, 650 F. Supp. 218 (E.D. Va 1986); and M.P.E.P. § 1850.

The Office Action has failed to satisfy its burden in showing that claims lack of unity under the requirements of PCT Rules 13.1 and 13.2.

Determination of the lack of unity is possible only when the claims of different groups lack a "special technical feature" relative to one another. In the present case, claims of Group II, i.e., claims 14-16 are directed to a compound of formula (I), whereas the claims of Group II, i.e., claims 9-13 are drawn to methods of treatment by administering the compound of formula (I). As such, the compound of formula (I) of elected claims 14-16 must be present in the method of treatment of claims 9-13. Consequently, all of these pending claims in Groups I and II share the same special technical feature, i.e., the compound of formula (I). For this reason, the claims have unity of invention.

Moreover, the Examiner's attention in this regard is directed to PCT Rule 13.2 in Part 1b of the Annex B of the administrative instructions under the PCT, which specify that "special technical features" is defined as meaning those features that define the contribution which each of the inventions, considered as a whole, makes over the prior art. In other words, PCT Rule 13.2 is art-based and requires the citation of a publication showing the "special technical feature". Therefore, absent any showing that the "special technical feature" shared by

all the pending claims is present in the present prior art reference, no determination of lack of unity can properly be made. As the Office fails to provide such a citation, Applicants believe that the lack of unity requirement is improper as a matter of law.

Also, in applying this same legal standard with similar claims, the International Searching Authority did not determine the unity of invention as lacking. Thus, the Patent Office has the benefit of the search report, but fails to explain why a different legal conclusion was reached.

Thus, it is respectfully submitted that had unity of invention been applied, unity would have been found to exist and all of the claims would have been examined together in this application. In this regard,

Lastly, even if US restriction practice were to be applied, it is believed that restriction would have been improper. It is well established that there are two criteria for a proper requirement for restriction: (1) the inventions must be independent (see M.P.E.P. §§ 802.01, 806.06, and 808.01) or distinct as claimed (see M.P.E.P. §§ 806.05 to 806.05(j)); and (2) there would be a serious burden on the examiner if restriction is not required (see M.P.E.P. §§ 803.02, 808, and 808.02). For the reasons noted above, the claims of Groups I and II contain overlapping and related subject matter, i.e., the

compound of formula (I). Consequently, a search of the invention of Group I (a method of using the compound of formula (I) of Group I) would necessarily overlap that of Group II. Thus, it is believed that a search of all the claims in their entire scope will not constitute a serious burden on the Office given their related and overlapping subject matter.

For these reasons, Applicants submit that the Office's requests for restriction and species election are improper. Thus, kindly search and examine of all the claims in their full scope together in this application as the inventions of Group I and Group II have unity of invention.

In the event that the Office disagrees with the traversal and maintains the requirement, then kindly consider the possibility of rejoinder of the non-elected invention, upon a determination of allowance of the elected invention, per U.S. rejoinder practice (See M.P.E.P. § 821.04).

Also, please consider and examine additional species, upon a determination of allowance of the generic claims, in accordance with U.S. election of species practice.

Favorable action on the merits is solicited.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON

*Jay F. Williams*  
\_\_\_\_\_  
Jay F. Williams, Reg. No. 48,036  
Customer No. 00466  
209 Madison Street, Suite 500  
Alexandria, VA 22314  
Telephone (703) 521-2297  
Telefax (703) 685-0573  
(703) 979-4709

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